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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,771	10/07/2003	Muhidin A. Lelic	20397.839.301	8325

7590 10/20/2004

MOSER PATTERSON & SHERIDAN LLP
3040 Post Oak Boulevard Suite 1500
Houston, TX 77056

EXAMINER

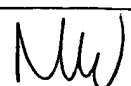
HELLNER, MARK

ART UNIT PAPER NUMBER

3663

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/681,771	Applicant(s) LELIC, MUHIDIN A.	
	Examiner Mark Hellner	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 35-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 35-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15, 25 and 26 of U.S. Patent No. 6,687,045. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Claim 35 of the present application is taught to a person of ordinary skill in the art by claims 15, 25 and 26 of USPN 6,687,045 in the following manner:

A variable gain optical amplifier (preamble of claim 15), comprising: a first amplifier stage including an input, an output, an optical pump, and a power source for the optical pump (lines 2-4 of claim 15); a second amplifier stage including an input, an output, an optical pump, and a power source for the optical pump (also lines 2-4 of claim 15); a variable optical attenuator coupled to the output of the first amplifier stage and the input of the second amplifier stage (claim 15, lines 5-7), the variable attenuator

Art Unit: 3663

including a setting indicative of an attenuation of the variable optical attenuator (this clause is suggested to the skilled artisan by lines 8 and 9 of claim 15 because these lines teach that a change in position corresponds to a change in attenuation); a first optical tap indicative of an optical power of the input of the first amplifier stage (claim 26, lines 2-3); a second optical tap indicative of an optical power of the output of the second amplifier stage (claim 26, lines 2-3); and controller circuitry (claim 15, line 10) including one or more inputs coupled to the first optical tap, the second optical tap, and the setting of the variable optical attenuator (suggested by the first , second gain detecting circuits and controller position indicating circuit recited by claim 15); one or more outputs coupled to one or more of the power source for the optical pump of the first amplifier stage and the power source for the optical pump of the second amplifier stage (this structure would have been suggested to a person of ordinary skill in the art by the requirement of claim 15 of a signal processor maintaining a selected gain setpoint because an amplifier's gain is conventionally set by control of its pump), wherein the controller circuitry maintains a flat total gain of the first amplifier stage and the second amplifier stage, based at least on the optical power of the input of the first amplifier stage, the optical power of the second amplifier stage and the setting indicative of the attenuation of the variable optical attenuator (a flat gain response is the most desired setpoint for amplification of WDM signals and, as such, would have been suggested by lines 17-22 of claim 15.

The third optical tap set forth by claims 36 and 37 is taught by the structure of the second gain detecting circuit of claim 26.

Art Unit: 3663

Allowable Subject Matter

Claims 35-37 will be allowable upon filing of a terminal disclaimer.

The closest prior art to claims 35-37 is shown by figure 17 of Sugaya. This figure discloses a first amplification stage (80), a second amplification stage (50), a variable attenuator (11), power detectors (28, 29, 92, 52 and 57) and control means (12, 25 and 53). Claim 35 defines over Sugaya for at least claiming that the variable attenuator include a setting indicative of an attenuation of the variable optical attenuator. Claims 36 and 37 are derived from claim 35.

Any inquiry concerning this communication should be directed to Mark Hellner at telephone number 703 306 4155.

Mark Hellner

Primary Examiner

AU 3663

A handwritten signature in cursive script, reading "Mark Hellner".